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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,175	03/31/2004	Leo M. Kenen	P0962D	7867
23735 7590 02/25/2008 DIGIMARC CORPORATION 9405 SW GEMINI DRIVE BEAVERTON, OR 97008				
EXAMINER				
SAN JUAN, MARTINERIKO P				
ART UNIT		PAPER NUMBER		
2132				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/816,175

Applicant(s)

KENEN ET AL.

Examiner

MARTIN JERIKO P. SAN JUAN

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date 11/29/2007.
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This is a response to Applicant's Remarks filed on November 6, 2007.

Claims 1-28 are originally pending.

Claims 1-20 have been cancelled. New claims 29-31 have been added.

Claims 21-31 are currently pending.

Amendments to the Specification and the Abstract of disclosure have been accepted.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claim 21 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 11 of copending Application No. 10/893149. Although the conflicting claims are not identical, they are not patentably distinct from each other because the obtaining a watermark key of the instant application can be read as the mathematical relationship of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

1. Applicant's arguments filed on November 6, 2007 have been fully considered but they are not persuasive.

Applicant respectfully argues that Lawandy provides no teaching or even suggestion that the physical characteristics of the document convey jurisdictional information related to the document.

The Examiner respectfully disagrees. Applicant defines jurisdiction data as "eg. data associated with an issuer of an identification document" [Specification, Pg 17, par 65]. The Examiner previously noted that physical characteristics, or attributes of the ID documents [US 2001/0037455 A1, Pg 2, Par 0033-0037] of Lawandy read on jurisdictional information. Lawandy conveys information relating to jurisdiction information when disclosing as "for example, that a watermark may be printed within the substrate of a negotiable instrument which includes regarding the value and the originator of the instrument" [US 2001/0037455 A1, Pg 1, Par 0003]. Further evidence of jurisdiction information can also be found in US 2001/0037455, Pg 1, Par 0008 regarding currency. Security features denoting which national treasury the currency is authenticated reads on jurisdiction information. Lawandy discloses an example of a security feature that gives the receiver a means to verify a particular (currency) note's authenticity, in which the security fiber is embedded in the paper on which the money is

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printed, and may include a human readable description of the currency imprinted on its surface. In US 2001/0037455, Pg 3, Par 0048, the taggant and/or semantic information [which are the physical characteristics or attributes of the ID documents] would have denoted jurisdictional information for authenticity.

The Examiner is maintaining the rejections previously taken.

2. New claims 29-31 have been fully considered. Upon further consideration, a new ground(s) of rejection is made in view of previously cited art by Lawandy et al. [US Pub 2001/0037455 A1], previously cited art by Hudson et al. [PCT Pub WO/2001/095249], and previously cited art by Chen et al. [US PN 5694471]. Refer to Prior Art Rejection Section below.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claim 21-22, and 24-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Lawandy et al. [US Pub 2001/0037455 A1].

Based on independent claim 21, Lawandy et al. teach a method of verifying a document comprising: determining jurisdictional information related to the document [Pg 2, Par 0033-0037. Jurisdictional information can be physical characteristics or attributes of the ID document.], wherein the jurisdictional information is used to obtain a watermark key which is related to a digital watermark embedded in the document; and using the key to extract the digital watermark embedded in the document [Pg 3, Par 0046] [Pg 3, Par 0052] [Pg 3, Par 0054].

With regard to dependent claim 22, Lawandy et al. teach the method of claim 21, wherein the document comprises a machine-readable feature, which carries the jurisdictional information, and wherein said determining step comprises reading the machine-readable feature [US Pub 2001/0037455 A1, Pg 3, Par 0054 – Such information can be stored anywhere in the card.].

With regard to dependent claim 24, Lawandy et al. teach the method of claim 21 wherein the jurisdictional information is combined with predetermined data to form the watermarking key [US Pub 2001/0037455 A1, Pg 3, Par 0044-0046].

With regard to dependent claim 25, Lawandy et al. teach the method of claim 21, wherein the jurisdictional information comprises the watermarking key [US Pub 2001/0037455 A1, Pg 3, Par 0052].

With regard to dependent claim 26, Lawandy et al. teach the method of claim 22, wherein the jurisdictional information comprises the watermarking key [US Pub 2001/0037455 A1, Pg 3, Par 0052].

With regard to dependent claim 27, Lawandy et al. teach the method of claim 21, wherein the jurisdictional information is mathematically related to the digital watermark through a cryptographic relationship [US Pub 2001/0037455 A1, Pg 3, Par 0044-0048, Examiner notes a key to decode information encoded in the digital watermark.].

With regard to dependent claim 28, Lawandy et al. teach the method of claim 21, wherein the jurisdictional information is mathematically related to the digital watermark through a watermarking key [US Pub 2001/0037455 A1, Pg 3, Par 0044-0048, Examiner notes a key to retrieve information encoded in the digital watermark.].

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 23 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawandy et al. [US Pub 2001/0037455 A1], and further in view of Chen et al. [US PN 5694471].

With regard to dependent claim 23, Lawandy et al. teach the method of claim 21, but does not teach wherein the jurisdictional information comprises an index, which is used to interrogate a database to obtain the watermarking key.

Chen et al. teach jurisdiction information organized as a tree structure type database stored in the identification document [Jurisdiction information also comprise "pointers" to retrieve key information from a database organized as a tree structure.] [US PN 5694471, Fig 3A and Fig 3B] [US PN 5694471, Col 9, Ln 53-55]. Chen is analogous art because it is in the same inventive field of counterfeit proof identification documents.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Lawandy et al. by storing information in the identification document as a tree structure type database because the counterfeit proof identification document has storage elements capable of storing such information. The suggestion/motivation for combining would have been to provide for multiple account records in a single identification document [US 5694471, Col 8, Ln 46-49]. Therefore, it would have been obvious to combine Chen et al. and Lawandy et al.

Regarding claim 31, Lawandy teaches the method of claim 29 wherein the watermark is related to other machine readable data on the document through a relationship utilizing

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keys [US Pub 2001/0037455 A1, Pg 3, Par 0048]. Lawandy does not teach wherein the relationship utilizing keys is through a public-private key pair.

Chen teaches a relationship wherein utilizing keys is through a public-private key pair with machine readable data on the document.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Lawandy et al. by having a public-private key pair relationship when utilizing keys with data on the document. The suggestion/motivation for combining would have been to provide for a cryptographic system utilizing public-private key pairs for added security feature [US 5694471, Col 1, Ln 32-51]. Chen et al. is analogous art because it is in the same inventive field of counterfeit proof identification documents.

2. Claims 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawandy et al. [US Pub 2001/0037455 A1], and further in view of Hudson et al. [PCT Pub WO/2001/095249].

Regarding claim 29, Lawandy teaches the method of claim 21 wherein the watermark is embedded in an optical device/image on the document [US 2001/0037455 A1, Pg 3, Par 0052]. Lawandy does not teach wherein the optical device/image is an optically variable device.

Hudson teaches watermark is embedded in an optically variable device (OVD) [WO/2001/095249, Pg 7, Ln 11-18] [WO/2001/095249, Pg 28, Ln 29 thru Pg 29, Ln 12]. [Digital watermarking is an additional or secondary coding that allows for another level of security/verification (WO/2001/095249, Pg 8, Ln 13). It is open for use with any identification data taught in Pg 28, Ln 29 thru Pg 29, Ln 12.].

It would have been obvious to one of ordinary skilled in the art at the time of invention to modify optical device/image of Lawandy into optical variable devices as taught by Hudson. The suggestion/motivation for having optical variable devices is the added security in the technology behind producing optical variable devices. Hudson is analogous art because it is in the same inventive field of counterfeit proof identification documents.

Regarding claim 30, Lawandy and Hudson teach the method of claim 29 wherein the optically variable device comprises a hologram [WO/2001/095249, Pg 25, Ln 8-12] [WO/2001/095249, Pg 24, Ln 10-20].

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARTIN JERIKO P. SAN JUAN whose telephone number is (571)272-7875. The examiner can normally be reached on M-F 8:30a - 6:00p EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MJSJ/

Martin Jeriko San Juan
Examiner, Art Unit 2132

/Gilberto Barron Jr./

Supervisory Patent Examiner, Art Unit 2132